

REMARKS

Claims 1-26 remain in this application. Reconsideration of this application is requested.

In response to the Board decision of July 11, 2003, affirming the rejection of claims 19-26 as being unpatentable over Wiedeman in view of Murata and rejecting patented claim 1 as being unpatentable over Wiedeman in view of Murata under 37 CFR § 1.196(b), independent claims 1, 19, and 23 have been amended to overcome the Board's rejection and to more explicitly correlate the claimed invention with appellants' arguments as alluded to in the Board's decision.

The Board concluded that it would have been a matter of design choice to integrate the switch and controller of the Murata system into the terrestrial transceiver rather than the satellite transceiver as is explicitly disclosed and taught by Murata, and then to apply the Murata reference as modified to the Wiedeman reference. This conclusion is submitted to be in error as it is based on an improper modification of the prior art. In particular, the rejection of claims 19-26 was based on a proposed modification of the Wiedeman reference according to the alleged teachings of the Murata reference.

In sustaining the rejection, the Board failed to apply the teaching of the Murata reference as it would have been received by one of ordinary skill in the art to the Wiedeman patent. Instead, the Board improperly modified the Murata reference, even though the Board found that "Murata does not provide any rationale why one transceiver is more desirable than the other to be integrated." (Board opinion at 8.)

To support an obviousness rejection under 35 U.S.C. § 103 it must be shown why one of ordinary skill in the art would have been led to make the proposed modification of the prior art to arrive at the claimed invention. In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In the present case, there has been no *prima facie* showing of obviousness because there has not been articulated any teaching, suggestion or motivation within the prior art to support the Board's conclusion of obviousness. To the contrary, the Board found that it would have been obvious to one of ordinary skill in the art to have modified the Murata reference as proposed because the Board that Murata provided no teaching, suggestion or motivation for the embodiment disclosed in Fig. 5.

Whether or not the Murata prior art "provides any rationale" for the disclosed embodiments is relevant to obviousness under 35 U.S.C. § 103 only to the extent as to whether Murata provides any teaching, suggestion, or motivation to those of ordinary skill in the art to make modifications of other prior art systems; the lack of any rationale in Murata does not serve as a substitute for evidentiary support for the conclusion of obviousness as to the modification of Murata, as is required under the existing case law precedent. The Federal Circuit has made clear in In re Lee, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002), and In re Zurko, 111 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997), that rejections must be supported by substantial evidence in the administrative record, and that where the record is lacking in evidence, the Board cannot and should not resort to unsupported speculation. The finding of whether there is a teaching, motivation or suggestion to modify the teachings of the applied prior art references must not be resolved based on "subjective belief and unknown authority," but must be "based on objective evidence of record." In re Lee, 277 F.3d at 1343-44, 61 USPQ2d at 1433-34.

The Board also stated that appellants' arguments as to reduction in size were not persuasive because the Board found neither explicit nor implicit claim limitations thereto. Board decision at 8-9. Claims 1, 19, and 23 have been amended to now explicitly set forth that the size of the satellite transceiver is reduced by eliminating therefrom the need for any input/output device by virtue of the signal input/output circuit being provided in the portable set. Murata fails to anywhere disclose or recognize such a benefit; to the contrary, as the Board stated, "Murata does not provide any rationale why one transceiver is more desirable than the other to be integrated." Board decision at 8.

The claims also have been amended to set forth that the user can carry out wireless terrestrial communication immediately upon disconnection of the portable set from the satellite transceiver without the necessity of making any further reconnections of communication equipment components, as explained in the brief on appeal. Neither Murata, nor Wiedeman, nor any combination of the two, anywhere recognizes, teaches, suggests or otherwise provides any motivation to one of ordinary skill in the art to have arrived at such a configuration.

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In view of the foregoing amendments and remarks, further and favorable reconsideration of this application and allowance of claims 1 and 19-26 is earnestly requested.

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